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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/807,018  
Filing Date: March 23, 2004  
Appellant(s): KALKANOGLU ET AL.

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John F. McNulty  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/2/2008 appealing from the Office action mailed 2/6/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-7,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koschitzky US 5664385.

Koschitzky teaches making roofing shingles by applying a hot hardenable asphalt/ adhesive onto a longitudinally moving base sheet and then applying adjacent areas of colored granules onto the surface of the sheet (col. 3, 3-43). As recognized on col. 4, there are **gradational overlapping color transition zones** 36 between the (three) different colored areas 26 a-c, per claims 2,4,6, as shown in figure 2 and taught on col. 4, 27-42. Subsequently, slots 76 are formed in each of the transition intermediate areas 36 between colored areas where the two blend drops are intermixed in order to form a “sharp visual demarcation between adjacent colored areas” (emphasis added) (col. 5, 4-18), the intermediate areas 36 each having a width. (Note the goal of the reference is the same as that of Applicants, see page 2, 4<sup>th</sup> paragraph.) Col. 5, 34-38 notes the remaining region of the transition areas are not noticeable to the eye because of the slot. Figure 2 shows width differences between colored areas 26 a-c to provide varied aesthetics between colored areas.

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Koschitzky teach removing overlapping transition zone, **preferably** (but not limited to) those areas containing about 50:50 of 2 adjacent blend drops, to provide a clear line of demarcation between adjacent colored areas (see col. 5, 17-19). Column 5, line 4+ states slots 76 are located in all or substantially all of the transition areas 36 between adjacent colored areas; further col. 7, 3-9 teach slots 76 may vary in width and appearance, and hence the sharpness of transition zones will vary depending on desired visual aesthetics. There is no evidence presented by Applicants that completely removing the intermediate across its width provides any mechanical or other advantage not cited by the reference. Thus it is the Examiner's position that the reference provides at least the suggestion for complete removal when conditions so necessitate, and further note there is no limitation against doing so. Modifying the teachings of Koschitzky for strictly decorative or aesthetic purposes does not patentably distinguish over the prior art but rather would have simply been an obvious modification. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431.

Summarizing Koschitzky, it carries out the same process as Applicants, preferably on the centered areas having an approximate 50:50 ratio of overlapping granules. Koschitzky is not limited to this scenario, nor is the reference limited as to width size (e.g. col. 7, 3-8). The goal is to provide a clear line of demarcation between adjacent colored areas and wherein transition is not visually noticeable (col. 5, 34-37). Thus, removal of more than just the most visible part of the overlapping region is merely an obvious modification because the result would predictably have been an even less chance of the overlapping region from being visually noticed, which is the main goal of the teachings of Koschitzky. The combination of familiar elements according to

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known methods is generally obvious when it does no more than yield predictable results, KSR, 127 Sup. Ct. at 1739, 2007. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Koschitzky by removing any or all of the width of the intermediate granule drop transition region as required by forming a slot to provide a desired ornamentation or aesthetic effect.

3. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koschitzky in view of the Admitted prior Art (APA), pages 1-2.

Koschitzky is cited for the same reasons previously discussed, which are incorporated herein. Applying second layers to make a laminated shingle is not cited.

The APA teaches it is known to form laminated shingles from two or more layers of shingle components. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Koschitzky by forming multi-layer laminated shingles as the shingle type as disclosed by the APA prior to slotting intermediate areas to form laminated shingles with sharp visual demarcations between adjacent colored areas.

### **(10) Response to Arguments**

The Examiner believes the issues at hand may be boiled down to two or three basic issues:

#1) given that both Applicants and Koschitzky teach to remove areas of a shingle containing overlapping colors of applied granules to provide “an accentuated visual demarcation between adjacent areas of granules” (Koschitzky, col. 2, 29-30) / leave “visually sharp, precise starting and ending delineations for the tabs of a given aesthetic” (Applicants’ abstract), would removal

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of all of an overlapping area patentably differentiate from potentially removing less than all of an overlapping area to provide aesthetic variations?, and 2) Koschitzky expressly teaches the goal of an accentuated visual demarcation between adjacent areas of granules, and one may **preferentially** remove the portion where the two color blend drops are approximately equal (col. 5, 17-18) but isn't it a fair reading that the overall teaching includes removing any amount (including all) of transition areas between adjacent areas or granules to achieve the demarcation (Koschitzsky abstract; col. 2, 1-14; col. 5, 4-14; etc) ?. Finally, the Examiner raises the additional question that since both claims and prior art are directed to the same issue for the same reason and utilize the same solution (i.e. to cut slots where there is granule overlap to achieve a shape visual demarcation between adjacent granule types on a shingle), would it not have been obvious to cut out any or all portions of the overlap to achieve a desired aesthetic/ visual demarcation effect because it is well-established that matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431. Given this summary, the Examiner will proceed to rebut Applicants' specific arguments.

## Section I

1. Applicants are in error that Koschitzky teaches away from removal of all transition areas, see again Koschitzsky abstract; col. 2, 1-14; col. 5, 4-14; etc. Applicants argument that the reference wants the opposite of complete removal is mis-placed since the opposite of complete removal is no removal of overlap at all.

Applicants refer to col. 5, lines 17-18 to support their contention, but have left out the critical word previous to "remove" which is "**preferably**"; Applicants argument simply refers to a

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preferred embodiment, not a requirement. The additional citations in arguments are simply carrying out this preferred embodiment. Applicants have ignored that the overall teachings are directed to the critical goal of removing transition areas in general because the “lack of a sharp dividing line between the adjacent different color areas of granules is highly undesirable” (col. 4, 39-41). Applicants continued arguments and examples only show that Koschitzky envisioned a wide range of variations to provide aesthetic effects between the adjacent areas. It remains the Examiner’s position that Koschitzky includes the removal of all of the transition zone to achieve the critical goal. Furthermore, the removal of all of the overlap area rather than some/ most of the overlap area is a matter related to the choice of ornamentation producing no mechanical effect or advantage and hence does not impart patentability, *In re Seid* 73 USPQ 431/2144.04 I of the MPEP.

It is respectfully submitted Applicants arguments are not convincing and fail to establish an argument for patentability over Koschitzky.

2. Applicants arguments regarding the Examiner’s use of KSR are unconvincing because they ignore the critical portion of the Examiner’s argument: “KSR establishes that design incentives, market forces, predictability, use of ordinary skill and common sense, and ordinary capabilities or ingenuity of one skilled in the art articulated by the Examiner may be relied upon to support obviousness.” Applicants have tried to dilute the Examiner’s previous point, which he is sure will not be lost on the members of the BPAI. That is, cutting all or part of the overlapping areas to achieve the mutual goal recited by both Applicants and Koschitzky is simply entailing “use of ordinary skill and common sense, and ordinary capabilities or ingenuity of one skilled in the art”, as was clearly articulated by the Examiner.



It is respectfully submitted Applicants arguments are not convincing and fail to establish an argument for patentability over Koschitzky.

3. Applicants argue the Examiner used hindsight and read into Koschitzky what wasn't taught. The Examiner experienced little temptation or "slippage into use of hindsight" in concluding the instant claims are obvious over the prior art. He has repeatedly and consistently articulated the reasons why and provided relevant supporting case law and MPEP citations.

It is respectfully submitted Applicants arguments are not convincing and fail to establish an argument for patentability over Koschitzky.

4. Applicants argue the validity of In re Seid as being an out-dated, pre-1952 test for patentability, and spend several pages trying to "overturn" the meaning of In re Sied.

The Examiner simply rebuts that the same reasoning and case law is present in section 2144.04 I of the MPEP, Eighth edition, Revision 6, Sept. 2007. The Examiner has therefore complied with the requirements of the latest available MPEP, which disagrees with Applicants' arguments that In re Seid is outdated. Its meaning as reproduced by Applicant is entirely relevant in the instant case because the claims provide neither mechanical effect nor advantage over Koschitzky that would establish patentability. The Snyder Declaration sets forth a list of features and purported advantages which the reader would readily realize are inherent to the shingles of Koschitzky as well. The tabs of Koschitzky would equally minimize the effects of thermal expansion; prevent bowing; the granules inherently prevent UV radiation; etc, etc , etc. There is absolutely no evidence that the slots which are the result of removal of all overlap areas provide these advantages. Finally, it is the Examiner's position that all these arguments are irrelevant because Koschitzky allows for removal of the entire transition area to achieve the

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previously cited goal, hence the same outcome would have been expected to produce the same product properties and advantages, if such advantages exist.

5. Applicants argue that the Snyder Declaration goes on to list and summarize an exhaustive list of patents (the reader would discover that most are directed to article claims) in which specific appearances have received patent protection. For example, Mr. Snyder points out developments in simulating natural shingles by changing granule coloration, thickness, etc. A summary of patentable changes directed to ornamentation effects/ providing “faux” appearances if you will, are provided: shingles simulating wood or tile; simulating / imitating structures or thickness variations; faux copper patinas; simulating thatched roofing when thatching is absent; simulating 3-dimensionality, shake shingles, snow drift appearance; etc, etc. The Examiner has no problem in these being inventive appearances for roofing so the Examiner has no issue with the well-written summary. In the instant case, there is no unexpected faux simulation: no clouds, snowdrifts, faux thickness variations, simulated thatching, or any other unexpected or novel visual representation, only an obvious variation of (or the same as) what the prior art already teaches. No unexpected or significant outcome results from the claimed method. A wider slot does nothing more than what Koschitzky requires of his method: forming sharp visual color demarcation. Thus there is little nexus between the issues regarding the rejection of the claims and the Declaration. And it is **fact** the prior art reference only teaches the 50:50 ratio zone to be a preference; it does not prevent removing more if there are other portions which visually impair the product given the repeated guidance of forming sharp visual demarcation.

6. The Examiner recognizes and applauds the long experience and technical credentials of Mr. Snyder, as well as recognizing the fact that he is employed by the Assignee. Mr. Snyder opines-

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without convincing evidence- from his summary that the instant claims are not obvious because they are not expressly taught in the prior art (#21). The reason may simply be that since the subject matter is patently obvious, it would have never been previously granted a patent for the same reasons this Examiner rejects the instant presented claims, particularly given the entirety of the teachings of Koschitzky.

7. Applicants assert the Examiner did “dismiss the evidence of commercial success as a secondary consideration..”. This is blatantly false. The Examiner stated: “Applicants have supplied some general information about supposed commercial success but have not supplied specific information regarding sales versus market and how the commercial success is derived from the advantages set forth in the specification. The meaning of the sales figures in context of total sales and other considerations (e.g. promotion/ advertising, market share, changes in business share, fluctuations in commercial need, etc) are entirely absent. A simple statement of opinion as provided in paragraph 20 is neither objective proof nor evidence, given that Mr. Snyder is/was employed by the assignee (CertainTeed) of this application. Attempting to belittle the objective information the Examiner requires in making a clear judgment of “commercial success” is not helpful. MPEP 1504.03 III states “When evidence of commercial success is submitted, **examiners must evaluate it to determine whether there is objective evidence of success, and whether the success can be attributed to the ornamental design**” (emphasis added). Clearly this requirement is on target relative to this case, and deems the arguments alleging commercial success to be inadequate and unpersuasive.” The general information supplied (date of first sales, and commercial release of information) includes, as is apparent, the Jenkins Declaration which the Examiner apologizes for not acknowledging by name. But the

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facts remain the same and so does the Examiner's position: Applicants have failed to meet the burden of proving commercial success as required by the MPEP to overcome the rejections under 35 USC 103.

#### **Section J**

The Examiner incorporates herein all previous facts and arguments above related to the obviousness of claims 1-7,11.

The Examiner does not fully understand the meaning of Applicants arguments of this section because they appear to be both repetitive and support the Examiner's position that Applicants are trying to patent aesthetics. This section discusses in details the advantages of aesthetic effects and the formation of the "sharp, precise lines of delineation". The Examiner does not dispute these arguments since he has stated, and continues to maintain, the claims are merely directed to aesthetics and not any unexpected mechanical or other advantage. MPEP 2144.04 I clearly states, among other things, that matters related to ornamentation only cannot be relied upon to define patentability. The Examiner maintains Applicants claims are obvious for this reasons and the reasons clearly articulated above and previously. Claims 9-10 are simply directed to applying a second layer. As the Examiner has previously pointed out, these steps are acknowledged in the Admitted Prior art as being known and conventional to form laminated shingles, hence the claimed steps would have been obvious .

It is respectfully submitted Applicants arguments are not convincing and fail to establish an argument for patentability over Koschitzky.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Frederick J. Parker

Conferees:

/Timothy H Meeks/

Supervisory Patent Examiner, Art Unit 1792

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700